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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Robert Noodelijk

On Appeal from: 1661

Serial No.: 09/923,534

Filed: August 8, 2001

For: CHRYSANTHEMUM PLANT NAMED 'ETNA'

APPEAL BRIEF TRANSMITTAL

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P. O. Box 1450
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Sir:

Attached hereto are three (3) copies of our Brief on Appeal in the above-identified application.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of

Robert Noodelijk

Serial No.: 09/923,534

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For: CHRYSANTHEMUM PLANT NAMED 'ETNA'

Group Art Unit: 1661

Examiner: Anne Marie Grünberg

BRIEF ON APPEAL

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BRIEF ON APPEAL

I. REAL PARTY IN INTEREST

The real party in interest is CHRYSANTHEMUM BREEDERS ASSOCIATION, N.V. of the Netherlands, whose ownership interest appears in an Assignment recorded August 8, 2001 at Reel 012064, Frame 0524.

II. RELATED APPEALS AND INTERFERENCES

Briefs on Appeal have been filed in application Serial Nos. 09/276,702, 09/708,588, and 09/902,750 on October 6, 2003, December 8, 2003, and January 13, 2004, respectively, which involve the same type of rejection before the Board as in this case.

III. STATUS OF CLAIMS

Claim 1 reads as it was filed with the application.

IV. STATUS OF AMENDMENTS

Although no change was made to the claim, a substitute application was filed with an Amendment Under 37 CFR 1.111 on December 31, 2002. Further changes to the specification were made in an Amendment Under 37 CFR 1.111 filed June 3, 2003. A Request For Reconsideration was filed October 28, 2003 in reply to the

Final Rejection mailed August 25, 2003. No present paper seeking a change either to the specification or to the claim is in the case.

V. SUMMARY OF INVENTION

The invention is directed to a new variety of chrysanthemum plant named 'Etna', which is described in the specification and depicted in the figures filed therewith.

VI. ISSUE

The sole issue before the Board of Appeals and Patent Interferences is whether claim 1 was properly rejected under 35 USC 102 as anticipated by PBR application No. NL PBR CHR 3164 filed October 22, 1999 and published November 16, 1999 (one of two applications listed in the Declaration and Power of Attorney) in view of the admission by appellant that 'Etna' was first offered for sale (outside the United States) in December 1999.

VII. GROUPING OF CLAIMS

There is one claim in the case and its patentability will be considered by the Board here.

VIII. ARGUMENT

The rejection is based upon two pieces of evidence, neither of which meets the definitions of proper prior art under 35 USC 102(b) .

A. The Published PBR Application is Not Enabling and Thus is Not Prior Art

The published PBR application used in the rejection is not enabling as the Examiner apparently has admitted. See lines 17 and 18 of page 4 of the Final Rejection mailed August 25, 2003 containing the acknowledgment that "no amount of detail will make a plant publication enabling unless the plant was publicly available." (Indeed, the USPTO seems officially to have acknowledged that PBR certificates are not enabling. See the Petition Decision mailed March 28, 2002 in application Serial No. 09/557,043, especially the fifth sentence in the third full paragraph on page 2 reading: "However, the PBR Certificate is not an enabled reference under 35 USC 102 unless coupled with public availability of the plant itself." Appellant does not agree with the breadth of the "unless" phrase. The sentence, however, states clearly the USPTO awareness that a published PBR application standing alone is not enabling, does not meet the requirements of the first paragraph of 35 USC 112, and thus is not prior art under 35 USC 102(b) . See In re Donahue, 776 F.2d 531, 226 USPQ 619 (Fed.

Cir. 1985). Thus, the published PBR application standing alone does not qualify as prior art under 35 USC 102(b).

The published PBR application may be a "printed publication" in a general sense but that published PBR application by both law (Donahue) and the USPTO's admission doesn't qualify as prior art under 35 USC 102(b). The source of the document (either domestic or foreign) is irrelevant when the text of that document is sufficiently lacking to disqualify the document as prior art under 35 USC 102(b).

The Examiner mentions on page 3 of the Final Rejection a section from Robinson on Patents regarding what constitutes a "prior publication" but the last three of the five elements listed establish that the published PBR application is not proper prior art here. The claimed subject matter was invented prior to the publication of the PBR application and that published application is not enabling. The reference thus is not proper prior art.

Appellant also disagrees strongly with the rationale expressed at page 4, lines 1 to 4 of the Final Rejection in justification of how the published PBR application is enabled. There the Examiner asserts, "By using the referenced publication [admitted to be non-enabled], one of skill in the art would have been able to contact the Applicant, Breeder, and Title Holder of the plant in question and subsequently obtain a plant since it was being marketed by

Applicant's own admission." The requirements for enablement under the first paragraph of 35 USC 112 deal with documents and no case law, including that discussed infra, of which the undersigned is aware has ever stretched a reed so thin in justification of a position asserting that an unenabling publication becomes enabling taken with other evidence that itself does not qualify as statutory prior art.

The United States Court of Appeals for the Federal Circuit recently reaffirmed in Elan Pharmaceuticals v. Mayo Foundation, No. 00-1467, October 2, 2003, that a non-enabling reference is not de jure prior art. The court through Circuit Judge Newman stated:

To serve as an anticipating reference, the reference must enable that which it is asserted to anticipate. 'A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.' Amegen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed.Cir. 2003) See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc. 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed.Cir. 2001) ('To anticipate the reference must also enable one of skill in the art to make and use the claimed invention.');

PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ('To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.')

(Slip op. at page 5.)

Lacking enablement, the publication is not anticipatory.

B. A Sale Abroad is Not a Patent
 Defeating Act and Thus is Not Prior Art

35 USC 102(b) specifies also that a patent-defeating act is public use of the invention or placing the invention on sale "in this country, more than one year prior to the date of the application for patent in the United States." Thus, public use of the invention outside the United States or placing the invention on sale outside the United States is not a patent-defeating act.

The error in the Examiner's position, we say with respect, is that the sale abroad is permitted to be considered jointly with the published PBR application. The sale is not prior art under Title 35 United States Code. The present situation is not analogous to that in In re Samour, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) where the rejection was based upon a consideration of two U.S. patents, each of which clearly qualified as prior art under 35 USC 102. Indeed, we have a situation here where neither piece of evidence relied on to support the rejection qualifies as prior art under 35 USC 102. The rejection to be proper must be made under statutory law, not metaphysical law.

C. Other Justifications Posed by the
 Examiner Do Not Make the Rejection Proper

The Examiner has also cited Ex parte Thomson, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) in support of the rejection. The

holding does not support the instant rejection. (The USPTO did not use Thomson as a basis for a rejection of this type until recently.) That case involved a utility application rather than a plant patent application. Moreover, the materials sold in that case were seeds, not plants. The Board panel justified its decision by stating that the necessary enablement came about "by purchase and planting of the requisite seeds." 24 USPQ2d at 1620. The panel also distinguished the situation in In re LeGrice, 133 USPQ 365 (CPA 1962) from the situation before it, pointing out, "Unlike the seeds of the asexually reproduced roses of LeGrice which would not produce the claimed rose, the sexually reproduce [sic] of the Siokra cultivar do reproduce the claimed Siokra cultivar." 24 USPQ2d at 1621. The panel in a footnote to the foregoing sentence remarked, "Another point of distinction is that whereas LeGrice concerned a plant patent, appellant seeks a utility patent, which affords a broader scope of protection." The Thomson and LeGrice cases presented distinctly different situations and neither bars patentably here. Indeed, LeGrice permits patentability in this case. The LeGrice court surely was aware that the plants in that case had been sold abroad; see the sentence in the first paragraph of the opinion reading "The publications occur in the National Rose Society Annual of England and in catalogues." 133 USPQ at 367. The court did not use those sales

as a basis to affirm the position of the Patent Office there. The court, rather, reversed the rejection under 35 USC 102 holding the publications to be non-enabling.

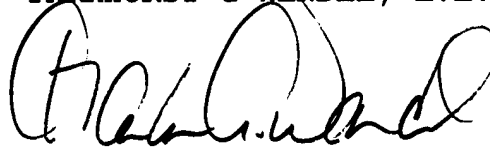
The holdings in neither In re Samour nor In re Donahue support the rejection. All of the references used in the "combined" 35 USC 102 rejections in those opinions were de jure prior art to the respective appellants. That situation does not exist here.

IX. CONCLUSION

For the foregoing reasons, it is respectfully submitted that claim 1 has been improperly rejected and the Board is asked to so hold.

Respectfully submitted,

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APPENDIX

A new and distinct variety of chrysanthemum plant as described and illustrated.